

John P. Parise
Senior Counsel

DAC



February 28, 2001

Dr. Richard Schwartz
Biotechnology Practice Specialist
Group 1600
United States Patent Office
Washington, D.C. 20231

Re: U.S. Patent Application No. 08/711,339

Dear Dr. Schwartz:

Could you please follow-up on this patent application. We had addressed the Petition in the past, but have had no response for almost one year.

Thank you for any assistance you could provide.

Sincerely,

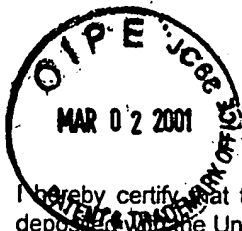
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CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

John P. Parize
(Print Name)

Date: March 27, 2000

(Signature)

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Binggeli et al

Group: 1613

Serial No. 08/711,339 filed September 6, 1996

Examiner: R. Ramseur

For: NOVEL PIPERIDINE DERIVATIVES HAVING RENIN INHIBITING
ACTIVITY

**PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE
COMMISSIONER UNDER 37 C.F.R. §1.181**

Nutley, New Jersey 07110
March 27, 2000

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

This Petition to Invoke the Supervisory Authority of the Commissioner under 37 C.F.R. §1.181 is filed to compel the Examiner to consider applicants' pending claims in their entirety. It is applicants' position that the Examiner has failed to follow both the law and Patent Office procedure, and this failure has

caused applicants to be denied due process in having their claims considered. Authority for the filing of this Petition can be found 37 C.F.R. §1.181(a)(3).

Applicants request that this Petition be granted and that either (i) the application be returned to the Examiner with the requirement that the Examiner examine and consider on the merits all claims that read upon the elected species in their entirety or (ii) the application be returned to the Examiner with the requirement that the Examiner respond to applicants' Appeal Brief, dated February 22, 1999, so that the Board can address the issues.

Before addressing the facts and legal basis for the granting of this Petition, applicants wish to thank Dr. Richard A. Schwartz who has discussed this application with applicants' attorneys on several occasions, who was instrumental in having the application revived after being improperly abandoned by the Examiner, and who helped applicants with regard to moving this matter forward.

Statement of Facts

The subject application was filed on September 6, 1996. Claims 1-41 and 43-137 are pending. Claims 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77, 87-90 directly read upon the elected species. Claims 18, 19, 21-31, 34, 46, 48-67, 73, 75, 76, 79-86, and 91-136 do not read upon the elected species.

A first Office Action, dated October 17, 1997, stated that claim 1 "is generic to a plurality of disclosed patentably distinct species Applicant is required under 35 U.S.C. 121 to elect a single disclosed species Upoon [sic.] the election of a single disclosed species, a generic concept inclusive of the elected species will be determined by the Examiner for examination along with

the elected species." This Examiner-created "generic concept" is crux of the dispute described below.

Applicants responded to the October 17, 1997 Office Action by filing an Amendment, dated November 7, 1997, which stated

"In response to this election requirement, applicants request that the species claimed in new claim 137, i.e. (3R,4S,5S)-3-(1,4-dimethoxy-naphthalen-2-ylmethoxy)-4-[4-[3-(2-methoxy-benzyloxy)-propoxy]-phenyl]-piperidin-5-ol, (and supported in Example 112 – compound 11 and Example ZZ) be examined at this time. Applicants look forward to the species embodied by the compound of claim 137 being found patentable and to a further determination of patentability for the genus that includes this elected species, as embodied in claim 1."

In an Office Action dated March 23, 1998, the Examiner acknowledged that

"applicant has elected the species of claim 137 with traverse." The Examiner created a "generic concept as depicted in claim 1 where R¹ is aryl optionally substituted by lower alkyl, lower alkenyl, trifluoromethyl, lower alkoxy, hydroxy-lower alkoxy, alkoxy alkoxy, R² is phenyl or naphthyl each substituted by O-C₁₋₈ alkylene –O-C₁₋₈ alkylene-aryl wherein aryl is as defined for R¹; X is O,S; Z is lower alkylene; Q is absent; m is O (W is absent); R³ is hydrogen; R⁴ is OH Claims 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77 and 87-90 are objected to as containing non-elected subject matter. The objection may be overcome by limiting the claim to the subject matter indicated as being examinable, supra. Claims so limited would appear allowable. Claims 40, 78 and 137, presented in independent form or made dependent on an allowable claim, would appear allowable."

In a Communication, dated July 16, 1998, applicants stated their position that

"the Patent Office does not have the legal authority or create a 'generic concept' and require applicants to limit a particular claim to the subject matter indicated as being allowable The Patent Office has failed to follow both its own internal procedures as set

forth in the MPEP and the law in making the restriction requirement and withdrawing the mentioned claims from consideration Procedures for making an election of species are described in MPEP 809.02. Applicants made a species election in response to this Office Action. As set forth in MPEP 809.02, the Patent Office is required to perform a search for all claims readable on the elected species The MPEP does not authorize the Patent Office to derive a 'generic concept as depicted in claim 1' to be carved out of existing claims. Therefore the Patent Office has not followed its own internal procedure."

The section of MPEP 803.02 citing *In re Weber*, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 198 USPQ 334 (CCPA 1978) was brought to the Examiner's attention.

In an Office Action, dated September 25, 1998, the Examiner maintained the objection to the claims as set forth in the March 23, 1998 Office Action. As stated by the Examiner "The issue here is of restriction. 35 U.S.C. 121 gives the Commissioner the authority to restrict the examination to one invention." *In re Weber* and *In re Haas* was distinguished by the Examiner as allegedly being "involved in the rejection of claims under 35 U.S.C. 121 and the withdrawal of an entire claim."

In a Communication, dated December 22, 1998, applicants again argued that the "Patent Office has failed to follow both its own internal procedures as set forth in the MPEP and the law in making the restriction requirement and withdrawing the mentioned claims from consideration." Specifically, applicants argued that the Examiner did not follow MPEP 809.02 and that **"restriction within a single claim cannot be sustained under 35 U.S.C. §121."** "Withdrawal of applicants' claims, and in particular claim 1, from further

consideration due to an intraclaim restriction requirement amounts in fact to a rejection see *In re Haas*." Applicants simultaneously filed a Notice of Appeal.¹

An Appeal Brief, dated February 22, 1999, further supported the arguments that were made throughout the prosecution history.

In an Office Action, dated March 8, 1999, the Examiner announced "Prosecution on the merits is closed in accordance with the practice under *Ex Parte Quayle*." Also stated was "Failure to limit the claims to the elected subject matter may result in the abandonment of this application."

A Communication, dated May 5, 1999, stated "it is applicants' position that the Patent Office has in fact rejected all of the pending claims as a result of an improper restriction requirement. Future handling of this matter is now under consideration by the Board and the Group Director."²

A Notice of Abandonment, dated December 06, 1999, recited as a reason "Applicant's [sic.] failure to timely file a proper response to the Office Action of 3-8-99, i.e. to cancel the non elected subject matter."

Applicants contacted Dr. Richard A. Schwartz by telephone for the first time in late January concerning the Examiner's handling of this patent application. Dr. Schwartz informed applicants that their renewed petition had been denied and on February 10, 2000 (over two months after the Notice of

¹ Applicants also filed Petitions to have the restriction requirement withdrawn on November 11, 1998 and March 29, 1999. Both of these Petitions were denied. The question at issue in this Petition is whether the Patent Office followed the law and its own internal procedures in handling this application.

Abandonment) sent a facsimile copy of this Decision to applicants. Dr. Schwartz determined that the application had been improperly abandoned and had the application returned to pending status.

Applicants telephoned the Examiner to discuss the subject matter of this Petition. It was the Examiner's position that he would not consider claim 1 unless the claim were to be limited to the "generic concept" and that the Board could not review the application because there was no rejection to appeal. Applicants again telephoned Dr. Schwartz and were advised that the subject Petition would be applicants' most appropriate recourse.

Points to be Reviewed

- 1) Did the Examiner fail to follow Patent Office procedure as outlined in MPEP 809.02, *et seq.* when he asked for a species election and then, when provided with an elected species by applicants, created a "generic concept" instead of providing a complete action on the merits of all claims readable on the elected species?
- 2) Did the Examiner exceed his authority under 35 U.S.C. §121 when he created a "generic concept" inclusive of a species elected by applicants and required applicants to amend a single claim embracing the "generic concept" so as to only encompass the "generic concept" in order for that single claim to be examined and considered on the merits?

² The Examiner never responded to applicants' Appeal Brief. The Group Director eventually denied applicants' Renewed Petition. Dr. Schwartz sent the undated Group Director's Decision to applicants on February 10, 2000.

Arguments Relating to the Points to be Reviewed

The Examiner failed to follow Patent Office procedure as outlined in MPEP 809.02, *et seq.* when he asked for a species election and then, when provided with an elected species by applicants, created a "generic concept" instead of providing a complete action on the merits of all claims readable on the elected species.

MPEP 809.02 embraces the regulation set forth in 37 C.F.R. §1.146 which permits the Patent Office to "require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted **if no claim to the genus is found allowable**" (emphasis added). MPEP 809.02(a) states that "Examiners should use Form Paragraphs 8.01 or 8.02 to make election requirements." MPEP 809.02(c) states "An examiner's action subsequent to an election of species should include **a complete action on the merits of all claims readable on the elected species**" (emphasis added).

The Examiner of the present application did not use Form Paragraphs 8.01 or 8.02 and failed to provide a complete action on the merits of all claims readable on the elected species. Rather, the Examiner created a "generic concept" which he examined without any action on the merits with respect to all claims that are readable on the elected species. The MPEP is clear as to what actions an Examiner should take. In the present application, the Examiner clearly failed to follow the procedure set forth in the MPEP by not using Form Paragraphs 8.01 or 8.02 and failing to provide a complete action on the merits of all claims readable on the elected species.

The Examiner exceeded his authority under 35 U.S.C. §121 when he created a "generic concept" inclusive of a species elected by applicants and required applicants to amend a single claim embracing the "generic concept" so as

to only encompass the "generic concept" in order for that single claim to be examined and considered on the merits. The Board of Patent Appeals and Interferences has jurisdiction to hear applicants' appeal because the claims have been effectively rejected by failure of the Patent Office to examine applicants' claims under the guise of restriction under 35 U.S.C. §121. Such refusal to examine applicants' claims is tantamount to a rejection and appealable. *In re Hass*, 179 USPQ 623 (CCPA 1973) ("*Hass I*").

"An examiner's adverse action of this nature *is* a rejection, a denial of substantive rights. Review thereof must fall within the jurisdiction of the board. *Hass I* at 627 (emphasis in original text).

The restriction requirement made by the Examiner was made solely under 35 U.S.C. §121 and should proceed as in *In re Hass*, 198 USPQ 335 (CCPA 1978) ("*Hass II*").

It is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 U.S.P.Q. 328 (CCPA 1978) at pages 331-332,

"§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text).

In the subject application, the Examiner made the exact type of restriction expressly forbidden by the CCPA in *In re Weber* (such restriction is tantamount to a rejection). There is no basis under 35 U.S.C. §121 for the Patent Office to

make an intraclaim restriction requirement of claim 1 and the subsequent generic claims encompassing the species of claim 137.

Nothing in 35 U.S.C. §121 gives the Examiner legal authority to create a "generic concept" and require applicants to amend a particular claim so as to only claim the subject matter indicated as being allowable, i.e. claim 1 as limited to embrace the "generic concept." Applicants have the right under U.S. patent law to claim their invention using the limitations that they regard as essential to delineate the invention, as long as the requirements of 35 U.S.C. §112 are met. See *In re Weber* at 331.

As in *Hass I*, the claims in the present application were withdrawn from consideration not only in this application but also prospectively in any subsequent application because of their content. As the Examiner's "generic concept" is constructed, it would be impossible for applicants to garner in subsequent patent applications the remainder of the claims after the "generic concept" is cleaved out, especially with regard to the written description requirement.

If the Examiner is permitted to create a "generic concept", numerous issues arise as to who is the inventor of the "generic concept"? and does the specification provide a written description of the "generic concept"? Although

every species contained within the "generic concept" would be enabled by the specification, the "generic concept" *per se* could lack a written description in the specification as filed. This is the exact situation envisioned in *In re Weber* which states on page 331:

If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the sub-genera would be defined by the examiner rather than the applicant, it is not inconceivable that a number of the fragments would not be described by the specification.

Allowing the Examiner to proceed via a "generic concept" approach would be a disservice to all patent applicants and is not supported by the law. It is applicants' position that the Examiner must either allow or reject a claim that reads upon an elected species.

Action Requested

In view of the above, applicants request that this Petition be granted and that the subject application be remanded to the Examiner with the instruction to consider on the merits the entirety of claims 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77, 87-90, and if claim 1 is deemed patentable, then to consider on the merits claims 18, 19, 21-31, 34, 46, 48-67, 73, 75, 76, 79-86, and 91-136. Alternatively, applicants request the application be returned to the Examiner with the requirement that the Examiner respond to applicants' Appeal Brief, dated February 22, 1999, so that the Board can address the issues.

No fee is required in connection with the filing of this Petition. If any fee is deemed necessary, applicants authorize that the amount of any such fee be charged to Deposit Account No. 12-2525.

Respectfully submitted,



Attorney for Appellant(s)

John P. Parise

(Reg. No. 34403)

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340 Kingsland Street

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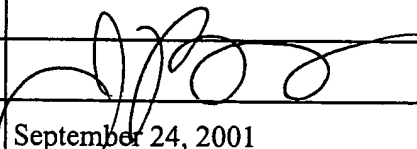
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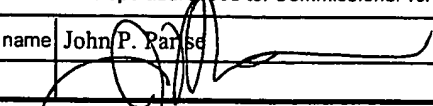
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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	08/711,339	
	Filing Date	September 6, 1996	
	First Named Inventor	A. Binggeli	
	Group Art Unit	1613	
	Examiner Name	R. Ramseur	
Total Number of Pages in This Submission		Confirmation Number	

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
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<input type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input checked="" type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Additional Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	John P. Parise
Signature	
Date	September 24, 2001

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231:	
Typed or printed name	John P. Parise
Signature	
Date	September 24, 2001

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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application:

Binggeli et al.

Group: 1613

Serial No. 08/711,339, filed September 6, 1996

Examiner: R. Ramseur

For: **NOVEL PIPERIDINE DERIVATIVES HAVING RENIN INHIBITING ACTIVITY**

STATUS INQUIRY

Nutley, New Jersey 07110
September 24, 2001

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Sir:

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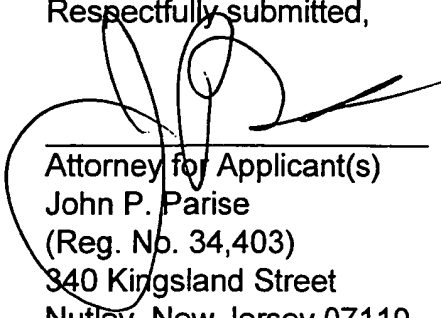
Applicants' filed a PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE COMMISSIONER UNDER 37 C.F.R. §1.181 mailed on March 27, 2000. Applicants have no record of any response communication from the Patent and Trademark Office and would appreciate knowing when a communication can be expected.

Applicants had discussed this matter with Dr. Brian Stanton, Biotechnology Practice Specialist, Group 1600, and provided him with a copy of the petition on June 15, 2001. Likewise, applicants had similar communications with Dr. Stanton's predecessor,

Serial No. 08/711,339
Filed: September 6, 1996

Dr. Richard Schwartz and provided him with a copy of our petition on February 28, 2001.
Despite diligent efforts by applicants, we have received no communication from the
Patent Office in about one and a half years.

Respectfully submitted,



Attorney for Applicant(s)
John P. Parise
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340 Kingsland Street
Nutley, New Jersey 07110
Telephone: (973) 235-6326
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Patent Office Stamp

Your Status Letter

Date September 24, 2001

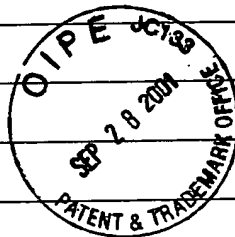
Ser. No. 08/711,339

Filed September 6, 1996

Binggeli et al.

NOVEL PIPERIDINE DERIVATIVES HAVING RENIN INHIBITING ACTIVITY

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Commissioner of Patents and Trademarks JPP:bh F/U 10/4/01



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/711,339 09/06/1996

Alfred Binggeli

4019/135

EXAMINER

Ramsuer, R.

Hoffman-LA Roche Inc.
Patent Law Department
340 Kingsland Street
Nutley, NJ 07110

ART UNIT

PAPER NUMBER

DATE MAILED: 1613

10/30/01

NOTICE UNDER 37 CFR 1.251 - Patent

☒ The file of the above-identified patent cannot be located after a reasonable search. Therefore, the Office is initiating the reconstruction of the file of the above-identified patent pursuant to the provisions of 37 CFR 1.251. *Socketed: April 20, 2001*

Patentee is given a period of **SIX (6) MONTHS** from the mailing date of this notice within which to provide a copy of patentee's record (if any) of all of the correspondence between the Office and patentee for the above-identified patent (except for U.S. patent documents), a list of such correspondence, and a statement that the copy is a complete and accurate copy of patentee's record of all of the correspondence between the Office and the patentee for the above-identified patent (except for U.S. patent documents), and whether patentee is aware of any correspondence between the Office and patentee for the above-identified patent that is not among patentee's records.

☐ The following paper(s) pertaining to the above-identified patent cannot be located after a reasonable search:

Therefore, the Office is initiating the reconstruction of such paper(s) pursuant to the provisions of 37 CFR 1.251.

Patentee is given a period of **SIX (6) MONTHS** from the mailing date of this notice within which to provide a copy of the paper(s) listed above and a statement that the copy of such paper(s) is a complete and accurate copy of patentee's record of such paper(s).

Alternatively, patentee may reply to this notice by producing patentee's record (if any) of all of the correspondence between the Office and the patentee for the above-identified patent for the Office to copy (except for U.S. patent documents), and provide a statement that the papers produced by patentee are patentee's complete record of all of the correspondence between the Office and the patentee for the above-identified patent (except for U.S. patent documents), whether patentee is aware of any correspondence between the Office and the patentee for the above-identified patent that is not among patentee's records. Such records must be brought to the Customer Service Center in the Office of Initial Patent Examination (Crystal Plaza 2, 2011 South Clark Place, Arlington, VA 22202).

If patentee does not possess any record of the correspondence between the Office and the patentee for the above-identified patent (or any copy of the paper(s) listed above), patentee must reply to this notice by providing a statement that patentee does not possess any record of the correspondence between the Office and the patentee for the above-identified patent.

☐ A printout from PALM of the contents of the file of the above-identified patent is included with this notice.

Direct the reply to this notice to:

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In re Patent No.:

Patentee: Applicant

Bingeli et al

Patent Date:

Application No.:

08 / 711, 339

Filing Date:

September 6, 1996

Direct to:

Box Reconstruction
United States Patent and Trademark Office
Washington, DC 20231

NOTICE UNDER 37 CFR 1.251 - Patent Application

Statement (check the appropriate box):

☒ The copy submitted with this reply is a complete and accurate copy of patentee's record of all of the correspondence between the Office and the patentee for the above-identified patent (except for U.S. patent documents), and patentee is not aware of any correspondence between the Office and patentee for the above-identified patent that is not among patentee's records.

☐ The copy of the paper(s) listed in the notice under 37 CFR 1.251 is/are a complete and accurate copy of patentee's record of such paper(s).

☐ The papers produced by patentee are patentee's complete record of all of the correspondence between the Office and the patentee for the above-identified patent (except for U.S. patent documents), and patentee is not aware of any correspondence between the Office and the patentee for the above-identified patent that is not among patentee's records.

☐ Patentee does not possess any record of the correspondence between the Office and the patentee for the above-identified patent.

Date

2/5/02

Signature

Typed or printed name

John Parise Reg. No 34403

A copy of this notice should be returned with the reply.

Burden Hour Statement: This collection of information is required by 37 CFR 1.251. The information is used by the public to reply to a request for copies of correspondence between the applicant and the USPTO in order to reconstruct an application file. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 60 minutes to complete. This time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

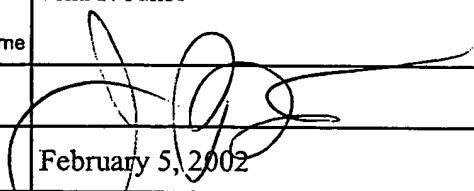
Please type a plus sign (+) inside this box → ☐

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Approved for use through 09/30/2000. OMB 0651-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	08/711,339	
	Filing Date	September 6, 1996	
	First Named Inventor	Alfred Binggeli	
	Group Art Unit	1613	
	Examiner Name	R. Ramsuer	
Total Number of Pages in This Submission		Confirmation Number	

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
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<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	Communication in Response to Notice Under 37 C.F.R. Section 1.251 and Reconstructed File and Notice Under 37 CFR 1.251-Patent, Signed
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	John P. Parise
Signature	
Date	February 5, 2002

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231:			
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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Binggeli et al.

Group: 1613

Serial No. 08/711,339, filed September 6, 1996

Examiner: R. Ramsuer

For: NOVEL PIPERIDINE DERIVATIVES HAVING RENIN INHIBITING ACTIVITY

COMMUNICATION IN RESPONSE TO NOTICE UNDER 37 C.F.R. § 1.251

Nutley, New Jersey 07110
February 5, 2002

Commissioner of Patents
Washington, D.C. 20231
Box Reconstruction

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Dear Sir:

OFFICE OF PETITIONS

This Communication is filed in response to the October 30, 2001 Notice Under 37 C.F.R. § 1.251 issued in connection with the above-identified patent application. A response to this Notice is due April 30, 2002.

Pursuant to the Notice, the Patent Office cannot locate the file of the above-identified patent application. In response to the Notice, applicants herewith submit (i) a copy of all correspondence between the Patent Office and applicants for the above-identified patent application, (ii) a list of such correspondence, and (iii) a statement that the copy is a complete and accurate copy.

Serial No. 08/711,339
Filed: September 6, 1996


Applicants' Statement

The submitted documents form a complete and accurate copy of applicants' records of all of the correspondence between the Patent Office and applicants for the above-identified patent application, and applicants are unaware of any correspondence between the Patent Office and applicants that is not among applicants' records.

If a telephone conference would be of assistance in furthering prosecution, applicants' undersigned attorney requests that he be contacted at the number provided below.

No fee, is required in connection with the filing of this Communication. If any fee is deemed necessary, authorization is given to charge the amount of any such fee to deposit account no. 08-2-525.

Respectfully submitted,



Attorney for Applicants
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Telefax: (973) 235-2363

117169

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1. September 28, 2001 PTO Receipt of Acknowledgment Card for Status Letter
2. September 24, 2001 Status Inquiry
3. June 15, 2001 Letter to Dr. Brian Stanton, Biotechnology Practice Specialist, Group 1600 with attachments
4. February 28, 2001 Letter to Dr. Richard Schwartz, Biotechnology Practice Specialist, Group 1600 with attachments
5. March 2, 2001 PTO Receipt of Acknowledgment Card for Status Inquiry
6. February 28, 2001 Status Inquiry
7. October 4, 2000 PTO Receipt of Acknowledgment Card for Status Inquiry
8. September 28, 2000 Status Inquiry
9. June 5, 2000 PTO Receipt of Acknowledgment Card for Supplemental Information Disclosure Statement
10. June 1, 2000 Request to Charge Deposit Account
11. June 1, 2000 Supplemental Information Disclosure Statement with references A5 and A6
12. March 31, 2000 PTO Receipt of Acknowledgment Card for Supplemental Information Disclosure Statement
13. March 28, 2000 Request to Charge Deposit Account
14. March 28, 2000 Supplemental Information Disclosure Statement with references B4, B5 and B6
15. April 6, 2000 PTO Receipt of Acknowledgment Card for Petition to Invoke the Supervisory Authority of the Commissioner Under 37 C.F.R. §1.181
16. March 27, 2000 Petition to Invoke the Supervisory Authority of the Commissioner Under 37 C.F.R. §1.181

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17. February 16, 2000 Fax from PTO, Richard A. Schwartz, Ph.D., Biotechnology Practice Specialist, Group 1600 to Bill Epstein, Esq.
18. Petition Decision
19. December 6, 1999 Notice of Abandonment
20. November 12, 1999 PTO Receipt of Acknowledgment Card for Status Inquiry
21. November 9, 1999 Status Inquiry
22. May 10, 1999 PTO Receipt of Acknowledgment Card for Communication
23. May 5, 1999 Communication
24. April 2, 1999 PTO Receipt of Acknowledgment Card for Renewed Petition to Commissioner Under 37 C.F.R. §1.144
25. March 29, 1999 Renewed Petition to Commissioner Under 37 C.F.R. §1.144
26. March 8, 1999 Office Action Summary
27. March 1, 1999 PTO Receipt of Acknowledgment Card for Appeal Brief and Request to Charge Deposit Account-Brief on Appeal
28. February 22, 1999 Appeal Brief
29. February 22, 1999 Request to Charge Deposit Account-Brief on Appeal
30. February 3, 1999 Petition Decision
31. December 28, 1998 PTO Receipt of Acknowledgment Card for Notice of Appeal and Communication in Response to September 25, 1998 Final Office Action
32. December 22, 1998 Notice of Appeal from the Primary Examiner to the Board of Appeals
33. December 22, 1998 Communication in Response to September 25, 1998 Final Office Action
34. November 16, 1998 PTO Receipt of Acknowledgment Card for Petition to Commissioner Under 37 C.F.R. §1.144

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35. November 11, 1998 Petition to Commissioner Under 37 C.F.R. §1.144
36. September 25, 1998 Final Office Action Summary
37. August 12, 1998 PTO Receipt of Acknowledgment Card for Supplemental Information Disclosure Statement
38. August 10, 1998 Supplemental Information Disclosure Statement with references B2 and B3
39. August 10, 1998 Request to Charge Deposit Account
40. July 20, 1998 PTO Receipt of Acknowledgment Card for Communication with Petition for Extension of Time
41. July 16, 1998 Petition of Extension of Time
42. July 16, 1998 Communication with references A2 and A3
43. Examiner Interview Summary Record, Paper Number 9
44. March 23, 1998 Office Action
45. November 10, 1997 PTO Receipt of Acknowledgment Card for Amendment / Power of Attorney to Associate Attorney
46. November 7, 1997 Amendment
47. November 7, 1997 Power of Attorney to Associate Attorney
48. October 16, 1997 Office Action
49. January 13, 1997 PTO Receipt of Acknowledgment Card for Claim for Right of Priority w/ Documents
50. January 6, 1997 Transmittal of Certified Copies
51. Filing Receipt
52. December 31, 1996 PTO Receipt of Acknowledgment Card for Information Disclosure Statement and References

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53. December 17, 1996 Information Disclosure Statement with International Search Report and references A1, A2, A3, A4, B1, C1, C2, C3, C4, C5, C6, C7, C8, C9, C10, C11, C12, C13, C14, C15, C16, C17, and C18
54. November 7, 1996 PTO Receipt of Acknowledgment Card for Response to Notice to File Missing Parts of Application
55. November 5, 1996 Response to Notice to File Missing Parts of Application
56. Executed Declaration and Power of Attorney for Patent Application
57. October 23, 1996 Notice to File Missing Parts of Application, Filing Date Granted
58. March 29, 1997 Notice of Recordation of Assignment Document
59. Assignment
60. March 20, 1997 Notice of Recordation of Assignment Document
61. Assignment
62. September 6, 1996 PTO Receipt of Acknowledgment Card for Patent Application
63. September 6, 1996 Patent Application Fee Sheet
64. Patent Application Specification
65. Declaration and Power of Attorney for Patent Application - Unsigned

10926US

Patent Office Stamp

Your COMMUNICATION IN RESPONSE TO NOTICE UNDER 37 C.F.R. §1.251

Date February 5, 2002

Ser. No. 08/711,339

Filed September 6, 1996

Binggeli et al.

NOVEL PIPERIDINE DERIVATIVES HAVING RENIN INHIBITING ACTIVITY
has been received in this office.

Commissioner of Patents and Trademarks JPP:bh F/U: 2/15/02

FU Mail for 6/15/02

No matches.
